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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,827

03/04/2004

Patrick Arachequesne

P24953

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7590

03/03/2009

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ART UNIT

PAPER NUMBER

3641

MAIL DATE

DELIVERY MODE

03/03/2009

PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/791,827
Filing Date: March 04, 2004
Appellant(s): ARACHEQUESNE, PATRICK

Edward G. Greive
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/28/08 appealing from the Office action mailed 9/11/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because applicant indicates that the "removably

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mounting *means*” recited in dependent claim 49 indicates a “dovetail groove 5” and a “dovetail-shaped strip 8. . .that is configured to fit in a dovetail groove 5”, this is incorrect in that the language of claim 49 does not invoke 35 U.S.C. 112 6th paragraph and thereby does not incorporate the specific structure disclosed in the specification . Claim 49 recites that the structure of the "removably mounting means" comprising a groove formed on the firearm, extending along a groove direction from a proximal end to a distal end (it is noted that applicant has not disclosed or claimed what constitutes the proximal end or distal end), and open at the proximal end, and a strip fixed to the sight device and having a shape so as to be received and guided in the groove along the groove direction. It is the firearm that comprises the abutment.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant’s statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,671,990	BOOTH	1-2004
5,483,362	TAI	1-1996
5,046,277	SANDERS	9-1991
6,490,060	TAI	2-2002

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(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 60 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Booth (US Patent # 6,671,990) in view of Tai et al (US Patent # 5,483,362). Booth discloses a firearm comprising at least one barrel having a muzzle end (reference 19) and an opposite end (reference 18). Booth discloses a rail attached to the barrel that can be utilized to mount sighting devices to the barrel. Booth does not explicitly teach a holographic sight mounted on the firearm. Tai et al. teaches a holographic sight that has the ability for mounting on firearms. All of the component parts are known in the references. The only difference is the combination of the old elements into a single device by mounting them on the mounting rail at the specific spot closer to the muzzle end. It would have been obvious to one having ordinary skill in the art to mount the holographic sight taught by Tai et al. onto a standard firearm and mounting rail as shown by Booth, since the operation of the holographic sight is in no way dependent on the operation of the other equipment of the firearm, and a holographic sight could be used in combination with a standard firearm to achieve the predictable results of improving aiming by utilizing the benefits disclosed by Tai et al. (col. 2, lines 30-67 including a wider range of positioning of the eye) and for the known benefits of holographic sights, such as unlimited eye relief (See cited nonpatented

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literature for characteristics of holographic sights) of a holographic sight with a firearm, to one of ordinary skill in the art at the time of the invention. It is noted that holographic sights are known for having unlimited field of view and unlimited eye relief, and therefore the placement of the holographic sight on the barrel and the distance of the sight from the users eye is independent of the sights ability to work as intended and is merely related to individual preference

(See cited nonpatent literature for the characteristics of holographic sights:

<http://www.opticsplanet.net/bushnell-holosight.html> (pgs. 1-5):

Ultimak (<http://Ultimak.com/UnderstandingE-sights.htm>) (pgs. 1-14);

Holographic Weapon Sight Product Introduction, NDIA/EOTech presentation, June 2004 (pgs. 1-25);

Knights Armament Company ([http://www.defensereview.com/article 106.htm](http://www.defensereview.com/article%20106.htm)) (pgs. 1-3); and

National Defense (<http://www.nationaldefensemagazine.org/issues/2004/Sep/Holographic.htm>) (pgs. 1-2)).

(See MPEP 2124 for references cited for showing factual characteristics and properties known at the time of invention). Furthermore, the [a) statements of intended use or field of use, b) "adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. It is noted that the holographic sight device **has the ability** of being mounted at any desired point on the barrel. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

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See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

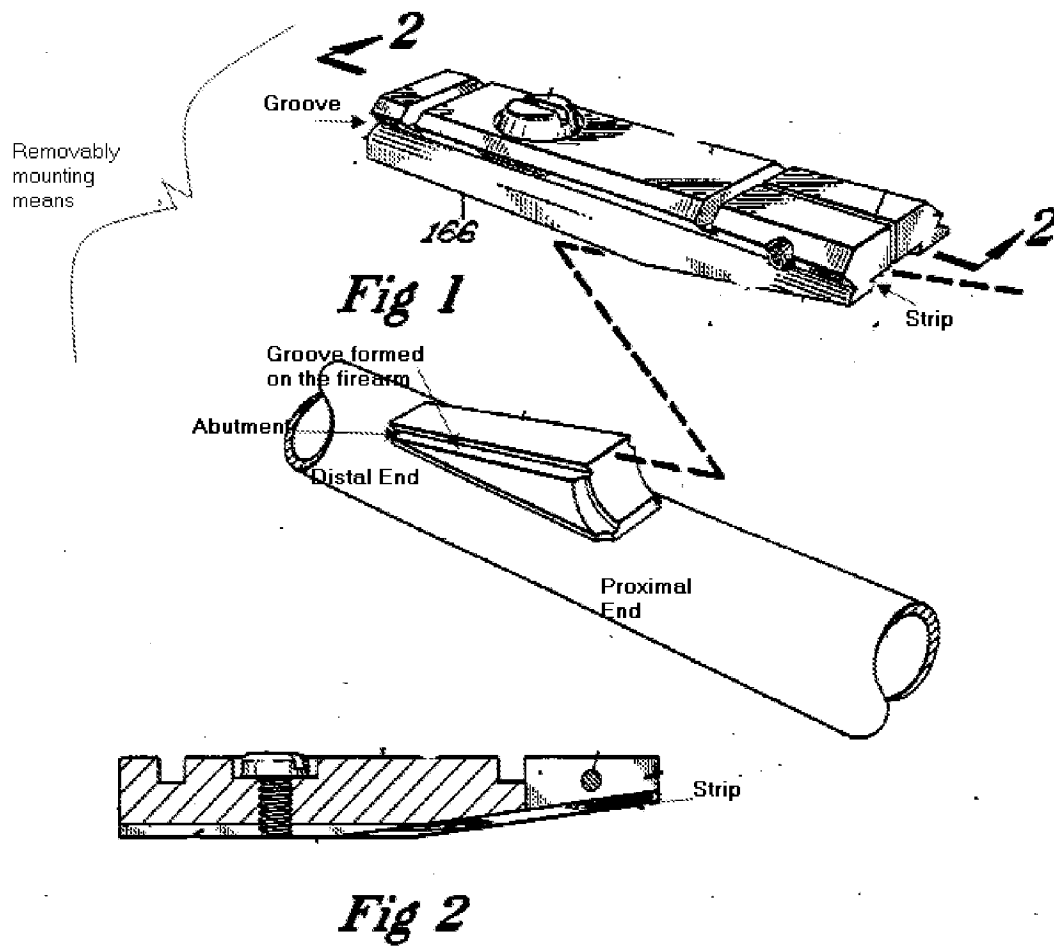
As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

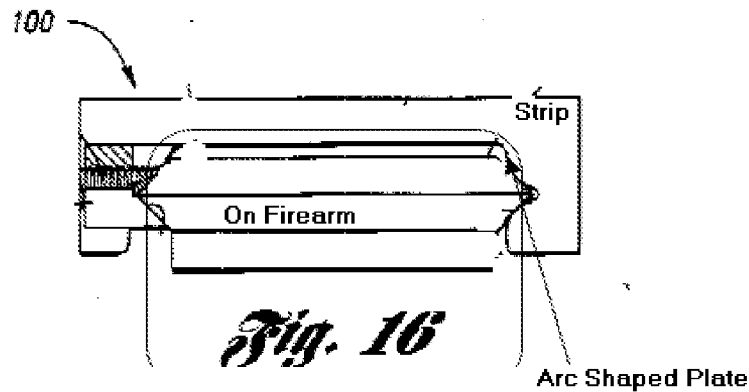
Claims 49-55, 58 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Booth and Tai et al. as applied to claim 60 above and further in view of Sanders (US Patent # 5,046,277) and Tai et al. (US Patent # 6,490,060). Although neither Booth nor Tai et al. ('362) expressly disclose the specific removably mounting, Sanders and Tai et al. ('060) does. Sanders teaches a specific mounting device that can be used for mounting any type of sighting device to a firearm. The mounting device being removable and comprising a groove/rib, formed on a firearm extending along a groove direction from a proximal end to a distal end (it is noted that applicant neither discloses nor claims what is the proximal or distal ends and since the terms are spatially relative terms they may be defined at any end in a figure) and open at the proximal end, the firearm comprises an abutment that is arranged and disposed such that when a matching strip is received in the groove and is submitted to a force along a longitudinal direction extending from one end to the opposite end, the strip is blocked in one longitudinal direction but is free to move in a direction toward the opposite end (it is noted that Sanders does not expressly disclose which end of the figures is the muzzle end but does expressly disclose that the drawings and terms "upper", "lower", "front", "rear", etc. only have reference to the drawings and not to any

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actual construction, therefore Sanders does not disclose the device as being dependent on the placement or direction of placement on a firearm. Furthermore, it is well known for sighting devices and other devices to be mounted at all locations on a barrel.) (Cl. 50, 51) The groove is a dovetail groove and is *essentially* parallel a longitudinal direction (it is noted that the term “essentially” does not require exactly). (Cl. 55) An abutment is provided at the distal end of the groove. (Cl. 58) The groove has the ability of being provided near or at the muzzle end and is provided on at least one lateral side of the rifle (it is noted that a firearm may be held in any manner to shoot in a horizontal direction, there is no inherent “upper side”, “lower side”, etc., (it is well known for a firearm to be shot with the trigger closer to the ground than the barrel and it is also well known for a firearm to be shot at 90° to that position, but it is also possible for a firearm to be shot rotated 180° to that position), therefore, absent any specific spatial definition, the term "lateral side" can be **any** side of the firearm. Tai et al. '060 teaches a specific sighting device mounting means comprising a strip having a shape to be received and guided in a groove of a mounting means on a firearm. The strip has a dovetail shape. The mounting means comprises an intermediary arc shaped plate extending from the strip and fixed to the sight device. The intermediary arc shaped plate is structured so that it supports the sight device so that the sight device is on top of the barrel. Because the references teach firearms, sights and mounts devices for firearms and sights, it would have been obvious to one skilled in the art to substitute one mount and sight for the other because the substitution of one known element for another would have yielded predictable results of quick mounting of a sight device to a firearm to one of ordinary skill in the art at the time of the invention.

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Tai et al. '060

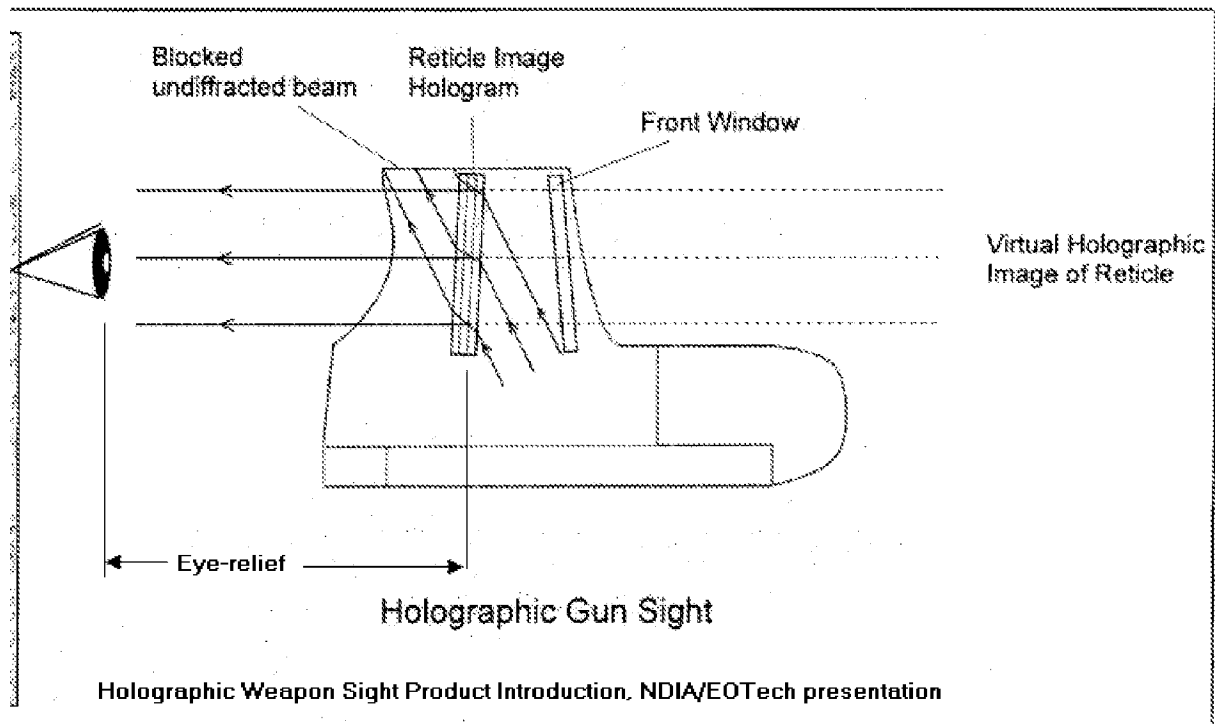
(10) Response to Argument

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant initially asserts that neither Booth nor Tai '362 disclose a firearm having a holographic sight mounted on the firearm closer to the muzzle end than the opposite end, however it is noted that it is not the examiner's position that any of the references individually show such. It is the combination of the references that are relied upon in the current rejections. Furthermore, it is noted that appellant has neither invented a firearm having a muzzle end nor a holographic sight, the current application is merely directed to the combination of two well known elements. Booth is cited for

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the disclosure of a firearm comprising at least one barrel having a muzzle end. Tai '362 is cited for the teaching of a holographic sight device. It is the combination of the references that is relied upon for the current rejection. It appears to be appellant's contention to have invented a new use for an old device, i.e. the known holographic sight device mounted closer to the muzzle end of the known firearm. Furthermore, applicant contends that since it is typical in the gun-sight device to mount holographic sights away from the muzzle end of a barrel, it is therefore not obvious to do so. However, it is noted that something typically done one way does not exclude it from being obvious to do it another way or in other word, teach-away from doing it another way. Booth and Tai '362 disclose all the claimed elements. The cited nonpatent literature shows that it is a known characteristic of holographic sights to have **unlimited** (or nearly unlimited) eye-relief (i.e. the distance the eye can be held from the sighting end of the device and still see the reticle, or sighting aperture, aligned with the target) Ultimak (<http://Ultimak.com/UnderstandingE-sights.htm>) (pgs. 8-9).

Holographic Gun Sight – Basic Concept (continued)



Bushnell HOLOSight has an eye-relief of ½"-10ft (<http://www.opticsplanet.net/bushnell-holosight.html> (pg. 2)). NDIA/EOTech states that HWS has "unlimited eye relief-adaptable to various weapon platforms or user preferences" (Holographic Weapon Sight Product Introduction, NDIA/EOTech presentation (pg. 16)). In explaining holosights, Ultimak states "with [] a holosight you do not need to have your eye aligned with the sight tube, or sight axis, and eye relief is no longer an issue. Ultimak pg. 3. Ultimak also states that "the unlimited eye relief allows mounting the optic forward of the receiver, farther from the eye" *Id.* pg. 9. It is this known characteristic of holosights that indicate that a holosight can be mounted at ANY location

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along the barrel of a firearm based on a user's preference without a change in its function (i.e. it will work equally as well mounted at either end of the barrel or anywhere in between).

Additionally, it is well known for firearm user's to utilize known optic mounts to mount known optics onto their known firearm at their own preferred position. All the claimed elements were known in the prior art, and one skilled in the art could have combined the elements by known methods with no change in their respective functions, and the combination would have yielded predictable results.

b. Rejection of claims 19-55, 58 and 59

In response to appellant's contention that the combination of Sanders and Tai '060 does not teach the specific removably mounting device, it is noted that appellant's arguments are narrower than the current claims. Appellant states that the firearm of Sander's is not an abutment, however the plain meaning of abutment is the contact point of two pieces, clearly the two pieces contact at the stated point. Sanders does not expressly disclose which end of the figures is the muzzle end but does expressly disclose that the drawings and terms "upper", "lower", "front", "rear", etc. only have reference to the drawings and not to any actual construction, therefore Sanders does not disclose the device as being dependent on the placement or direction of placement on a firearm. Furthermore, it is well known for sighting devices and other devices to be mounted at all locations on a barrel. Although Sanders does not expressly teach an end of which the abutment is, Sanders does teach an abutment, it would be obvious to one of ordinary skill in the art to place the abutment toward the end of the firearm in which the abutment was most useful, therefore putting the abutment at an end that resisted recoil forces would be obvious to one of ordinary skill in the art. In response to appellant's contention that

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the groove is not parallel to a longitudinal direction, it is noted that claims merely require that the groove be *essentially* parallel, since the application does not disclose how close to exactly parallel is required to be *essentially* parallel it is the examiner's contention that the groove of Sanders is *essentially* parallel. In response to appellant's contention that Sanders does not disclose a rib, it is noted the plain general meaning of a rib is a longitudinal strip of metal. The sight ramp of Sanders in the broadest sense of the term constitutes "a rib". In response to appellant's contention that Tai '060 illustrates a base having a groove that slides over a Weaver style dovetail rail, it is noted that the claims of the present application reads on a base that that slides over a Weaver style dovetail rail. The combination of the known elements would have yielded predictable results with no change to their respective functions.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Michelle (Shelley) Clement/
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